

REMARKS

This Amendment is being filed in response to the Office Action dated January 28, 2003. For the following reasons, this application should be considered in condition for allowance and the case passed to issue.

A set of formal drawings embodying the corrections made in the approved corrected drawings of November 14, 2002, are being submitted with this Amendment.

Claims 1-4, 9 and 11 were rejected under 35 USC §102(b) as being anticipated by Oshita. Claims 1-4, 9, 11 and 16-17 were rejected under 35 USC §102(e) as being anticipated by Theobald. Claims 5-8, 12-15 and 18-19 were rejected under 35 USC §103(a) as being unpatentable over Theobald. These rejections are hereby traversed and reconsideration and withdrawal thereof are respectfully requested.

Applicants again stress that the Examiner has failed to properly apply the required tests for examining claims cast in means plus function format, such as claim 1, and therefore failed to establish lack of novelty under 35 USC §102 for claim 1 and those claims dependent therefrom. As required by the MPEP, the Examiner must show that the prior art performs the identically claimed function, and uses structural equivalents to the structure disclosed in the specification. The Examiner states that Applicants' arguments are not commensurate with the scope of the claim, since claim 1 has no limitations of the guide arm and the guide motor providing drag on the tape being unloaded. However, the appearance of these limitations specifically in the claim are not necessary when means plus function format is used to cast elements in a claim. The Examiner is required, and it is not optional, to compare the structures of the allegedly anticipating reference with the structure disclosed in the specification to consider whether there is a structural equivalent. Thus, the Examiner

structural equivalent

must consider certain features of the present invention disclosed in the specification, such as the guide arm and the guide motor, which provide drag on the tape being unloaded. This was not done in the Office Action so that the rejection under 35 USC §102 of claim 1 and those claims dependent therefrom has no legal basis and is not in conformance with the requirements under 35 USC §112, sixth paragraph, judicial precedent and the MPEP requirements.

Further, the Examiner states that even if Oshita does not specifically disclose the guide arm and guide arm motor providing drag on the tape or being dragged by the tape, they inherently have it. The Examiner further states that unless the tape drive mechanism is frictionless, there will always be a drag or tension, no matter how minute, on each of the elements, provided by the opposing elements or just due to gravity or the weight of each element. Whether such forces can be shown to be present, (and the Examiner has not shown this to be true) it is of no moment since the present invention provides a controlled drag in a controlled application of force and does not rely just upon gravity or the minute tension that may possibly be provided by certain elements. If the Examiner's reasoning were to be followed, absurd results would be allowed. For example, the effect of the moon's gravity on the tape can also be considered to apply a force. The Examiner has not shown that one of ordinary skill in the art would take such minute forces into account. Nor has the Examiner shown that Oshita provides a controlled drag of the tape. In fact, Oshita does quite the opposite.

The Applicants referred to column 4, lines 32-40 of Oshita in the previous Office Action. This description shows that motor 21, seen in Fig. 3 of Oshita, rotates clockwise. This action pulls the leader block 3, to thereby insert the leader block 3 into the cartridge.

The guide arm motor is therefore applying force in the same direction as the travel direction of the tape. By contrast, as seen in Fig. 4 of the present application, the force of the motor in the present invention is in a direction opposite to that of the travel direction of the tape, as indicated by the force on the tape. The guide arm and the guide arm motor are not dragged in Oshita, but rather provide the motive force for movement of the leader block. As stated in Applicant's prior response, it is the guide arm and the guide motor that are dragged in the present invention, which applies the force (the drag) on the tape in a controlled manner.

For similar reasons, claims 9 and 16 are also patentable over Oshita. These claims have been amended to make clear that it is a controlled provision of drag on the tape and a controlled applying of tension to the end of the tape. Oshita failed to provide such a controlled drag. The functioning of gravity in the manner suggested by the Examiner does not supply such a positive controlling. As noted above, Oshita does not provide a guide arm motor and guide arm arranged to provide drag on the tape during unloading operation. Instead, the guide arm motor and the arms of Oshita actually move the leader block toward the supply reel. Likewise, claim 16 of the invention describes the applying of tension to an end of the tape in the direction toward the take-up reel. Oshita fails to disclose this applying of tension to the end of the tape in the direction toward the take-up reel during the unloading operation.

For all of the above reasons, the PTO has failed to establish that claims 1-4 and 9-11 are anticipated by Oshita under 35 USC §102(b). Reconsideration and withdrawal of this rejection are therefore respectfully requested.

The description in Theobald was provided in the earlier response filed in this application and is incorporated herein.

It is respectfully pointed out that the Examiner has provided no factual basis that the guide arm and the guide arm motor of Theobald are arranged to provide drag/tension on the tape and to be dragged/tension by the tape being unloaded from the tape drive mechanism. The Examiner has merely shown the load motor and the link 122 that is pivoted by the load motor move the take-up link between the connect and disconnect positions. There is no factual evidence provided by the Examiner that the link 122 actually provides drag/tension on the tape. It is unfair to the Applicants to assert that Theobald identically discloses each and every element of the claimed invention when such features are clearly not shown. The supposition that the tape drive mechanism provides a drag/tension in the particular claimed manner, without factual support is just that, a supposition. It is not the necessary factual evidence required to deny Applicants of their right to an issued patent.

The dependent claims further define the invention and have not been shown by the PTO as being disclosed or suggested by Theobald. For instance, claim 5 recites that the guide arm motor is under control of a controller arranged to provide tension on the tape by electrical induction within the guide arm motor. The Examiner states that the use of an induction motor as the guide arm motor is an obvious alternative design choice, but provides no support for this. There is no motivation suggested by the Examiner as to why one of ordinary skill in the art would have selected an induction motor that provides tension on the tape, nor a controller arranged to control the guide arm motor in such a fashion. Theobald makes no mention of such a controller that provides tension in the tape by controlling electrical induction within the guide arm motor. Again, the Examiner is respectfully requested to provide the column and line number where such description of the electrical induction within the guide arm motor is described, as well as the reference which shows that

the providing of tension of a tape is under the control of a controller. Similarly, claim 6 describes that the electrical induction, frictional resistance of the hub filler and frictional resistance of the guide arm applies force to the hub filler in an opposite direction to the direction that the hub filler is travelling in the unloading operation. There is no description whatsoever in Theobald of such forces. Likewise, claim 7 describes that the guide arm is arranged to provide tension by magnetic resistance within the guide arm motor. The Examiner has failed to provide any line of reasoning whatsoever or support that Theobald identically discloses such an arrangement. Similar limitations appear in dependent claim 11-15 and 17-20.

For all of the above reasons, the PTO has failed to establish that Theobald identically discloses each and every element or claimed step of the present invention, or makes obvious the invention under 35 USC §103. Reconsideration and withdrawal of the rejections of the claims under 35 SUC §102 and §103 are respectfully requested. In light of the amendments and remarks above, this application should be considered in condition for allowance and the case passed to issue. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this

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paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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